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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/361,849	07/27/1999	ROBERT SWENSEN	804 OP 710	6048
7590 02/20/2004			EXAMINER	
JEFFREY R GARGANO WALLENSTEIN AND WAGNER LTD 53RD FLOOR 311 SOUTH WACKER DRIVE CHICAGO, IL 606066622			EASTHOM, KARL D	
			ART UNIT	PAPER NUMBER
			2832	
DATE MAILED: 02/20/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/361,849

Applicant(s)

SWENSEN ET AL.

Examiner

Karl D Easthom

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,7-9,11,23 and 24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,7-9,11,23 and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 7-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The terms "main" and "sub" lack antecedent basis and it is not clear what structure is meant or required.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 23-24 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 9-69416.

JP'416 discloses the claimed invention at Fig. 1 and the abstract. Claim 23 is disclosed as follows: first and second polymer PTC elements 5, first, second, and third electrodes 6a, 6b, and terminations 8a, 8b. The sub portions of claims 2-3 are opposite the portions 132a and 132b. In claim 4, the joining is depicted between the two portions of 132b. In claim 5, see col. 7, lines 20-50 for the foil. In claims 7-9, first and second end terminations are in direct contact as claimed, and two layers are depicted.. In claim 11, the insulating layer is 138 which is on the first and second electrodes (even if there is another layer therebetween) and/or it directly touches 53 adjacent the area where it touches the PTC elements 51 so it is "on" there. In claims 23-24, all the electrodes are in electrical communication with each other, and the elements for claim 1 correspond as noted above.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-3, 5, 7-9, and 11 are rejected under 35 U.S.C. 103(a) as obvious over JP 9-69416 in view of Zhang et al. Barrett discloses the claimed invention as noted above with respect to like elements of claims 1, 23 and 24, except claim 1 requires the insulating layer on the first and second electrodes. The insulating layer is 85 of Zhang at Fig. 11 is depicted on electrodes, and in direct contact with the polymer, meeting claim 11, for the purpose of ensuring that the electrode portions of 13 do not short each other and for protecting the device. For claims 2, either of the first and second electrodes of '416 can be main or sub, where each is not required to have two portions. As an alternative, and for claims 2-3, Zhang discloses main and sub portions for the purpose of contacting the device so that such an arrangement would have been obvious. For claim 5, the electrodes appear to be foils where they are metal, however, it would have been obvious in view of Zhang to employ foils as suggested by Zhang since foils are useful and compatible with polymer devices. In claims 7-8, each of the electrodes are main and sub where the claim does not require two portions, or see the remarks for claim 3 above. For claim 9, JP '416 lacks the two layers, but Zhang discloses such layers at Fig. 11 as useful for circuit board attachment which would have been obvious given the chip of JP '416.

7. Claim 4 is rejected under 35 U.S.C. 103(a) as obvious over JP 9-69416 in view of Zhang et al, further in view of Nakamura (JP8250307). The claimed invention is disclosed as noted above, except for the main and sub portions of the third electrode and joining the elements

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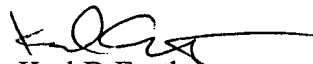
therebetween. Nakamura discloses the arrangement at Fig. 1 with main and sub portions 9a, 9b employed for the purpose of rendering the resistance accurate, so that it would have been obvious to split the electrodes into the two main and sub portions for that purpose. The claim does not require main to be larger than sub, for example, one can be main where the current is fed into it. If one is required to be larger than the other, it would have been obvious to render one slightly bigger than the other since no two items can be made exactly the same size without an increase in complexity and cost.

8. Applicant's most recent "Luciano Declaration" filed 12/5/03 is considered persuasive in overcoming prior art filed on or after March 3, 1998, so that Barrett '591 and Kojima (WO98/12715) do not qualify as prior art. The remaining arguments are moot due to the new grounds of rejection. Hence new art is here applied.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karl D Easthom whose telephone number is 703 308-3306. The examiner can normally be reached on M-Th, 5:30AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Elvin Enad can be reached on 703 308-1976. The fax phone number for the organization where this application or proceeding is assigned is 703 308-7722.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-0956.


Karl D Easthom
Primary Examiner
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